

# IP in business transactions: Russian Federation overview

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A guide to intellectual property law in the Russian Federation. The IP in business transactions Q&A gives an overview of maintaining an IP portfolio, exploiting an IP portfolio through assignment and licensing, taking security over IPRs, IP and M&A transactions, and the impact of IP on key areas such as competition law, employees and tax.

To compare answers across multiple jurisdictions, visit the IP in business transactions [Country Q&A tool](#).

This Q&A is part of the global guide to IP law. For a full list of jurisdictional Q&As visit [www.practicallaw.com/ip-guide](http://www.practicallaw.com/ip-guide).

## Overview of main IPRs

1. What are the main IPRs in your jurisdiction? How are they protected?

The following main IPRs are protected in Russia:

- Patents (including for inventions and utility models).
- Trade marks (including service marks).
- Copyrights (including computer programs and databases) and related rights.
- Design rights (that is, industrial designs).
- Know-how (including trade secrets and confidential information).
- Mask works (including layout-designs).
- Achievements of selection (including plant varieties and animal breeds).

### Patents

Patents can protect inventions and utility models. To be protected, they have to be granted and registered in Russia.

**Patents for inventions.** To be patentable, the subject matter of an invention must be a technical solution in any area of technology related to either of the following:

- A product (including a device, substance, micro-organism strain or culture of cells of plants or animals).

- A method (a process of conducting actions on a material object with the assistance of material means), including the application of a product or method for a certain purpose.

For an invention to be patented, it must pass the patentability test on novelty, an inventive step and industrial application.

The term of patent protection for inventions is 20 years from the filing date. However, patents for pharmaceuticals, pesticides and agrochemicals can be extended for another five years.

Patents for inventions can be obtained by filing the application with the Federal Service for Intellectual Property (Rospatent), or Eurasian/regional filing (including under the Patent Cooperation Treaty (PCT)).

**Patents for utility models.** A utility model is protected if it represents a technical solution related to a device. The utility model must be new and industrially applicable. The term of protection for utility models is ten years from the filing date and this period cannot be extended.

Patent applications for utility models (national and under PCT) must be filed with Rospatent.

### **Trade marks**

To be protected in Russia, a trade mark must be filed with Rospatent. However, as Russia is a signatory to the WIPO Madrid Agreement Concerning the International Registration of Marks 1891 (Madrid Agreement) and the Madrid Agreement concerning the International Registration of Marks and the Protocol Relating to that Agreement 2004 (Madrid Protocol), international trade mark registrations can also be protected in Russia. An unregistered mark, or mark-in-use, is not protected, unless it has obtained "well-known" status through registration with Rospatent.

Any words, pictures, three-dimensional configurations and other marks may be registered as trade marks. The registration of non-traditional trade marks, such as sounds, colours and smells, is not prohibited by the law. To be registered, a mark must be new and distinctive (inherent or acquired).

It is not necessary to use the mark before applying for registration, and proof of use is not required when the trade mark application is filed. The owner must start using the trade mark within three years of its registration. If the mark is not used during the three-year term, any interested person can apply for cancellation of the trade mark protection on the grounds of non-use.

The duration of the national trade mark registration process is approximately one year, and the registration process includes a formal and substantive examination.

When the trade mark is registered it is valid for ten years. Trade mark registrations can be renewed for additional ten year periods, an unlimited number of times.

### **Copyright**

Copyright subsists in scientific, literary and artistic works fixed in any tangible medium of expression, regardless of benefit, purpose and method of expression. A work of authorship is capable of copyright if it satisfies two fundamental requirements:

- Creativity (that is, it must be made as a result of the author's creative activity).
- Fixation (that is, it must be embodied in any material form).

The following examples of works of authorship can obtain copyright protection:

- Literary works.
- Dramatic works.
- Musical works.
- Choreographic works and pantomimes.
- Audio-visual works.
- Sculptural, graphic and design works.
- Architectural works.
- Pictorial works.
- Computer programs (software).

Copyright law also protects compilations (for example, databases) and derivative works (for example, translations).

Essentially, copyright vests in a work of authorship from the moment it is created. There is no need to register or comply with any other formalities to acquire, use, exercise, transact, protect or enforce the copyrighted work. Optional registration with Rospatent is available for software and databases at any time during the term of the copyright protection.

Copyright law generally protects moral rights and exclusive rights. Moral rights belong to the author of a work and are not subject to any assignment or licence. Moral rights and exclusive rights cannot be pledged or secured, and the waiver of such rights will be null and void.

The following moral rights remain with the author and will be protected perpetually:

- Right of attribution.
- Right of integrity.
- Right of publication.

The author of the work, or another copyright owner, has the exclusive right to do and to authorise any of the following actions with the work (original or copies):

- Reproduce (by writing, drawing, audio, video recording or any other means).
- Distribute (by sale or other transfer of ownership).
- Publicly display (by demonstrating directly or by way of technical means).
- Import (for the purposes of distribution).
- Rent (applies to software under certain limitations).
- Publicly perform (by showing live or by way of technical means).
- Broadcast (transmitting by radio, television or cable, including by way of retransmission).
- Translate or otherwise adapt (prepare a derivative work).

The exclusive right to any copyrighted work can be assigned, licensed, pledged or secured.

The general term of copyright protection is the life of the author plus 70 years following his death.

### **Design rights**

Design rights extend to solutions related to the outer appearance of articles. Design rights are patentable in Russia if they are new and original.

The essential features of a design right must define the aesthetic characteristics of an article, including its form, configuration, ornaments, combination of colours, lines, outlines, textures and patterns of materials. The technical functions of an article are not protected by design rights.

The initial term of protection for designs is five years from the filing date. The term of design protection can be extended several times for another five years. However, the maximum term of design protection must not exceed 25 years.

Patent applications for designs must be filed with Rospatent.

### **Trade secrets and confidential information**

Trade secrets and confidential information can be protected as know-how. Know-how must not be registered. However, the owner of confidential information must undertake certain reasonable measures to maintain the confidentiality of the relevant information. If such measures are not implemented, the confidential information will not be protected. The know-how must have an actual or potential value for it to be legitimately protected from third parties.

One of the legal ways to acquire know-how protection is to implement the "trade secrets regime". The owner must properly identify the confidential information, limit the access to the confidential information (by establishing the appropriate procedure for dealings with the same), affix the notice "trade secret" to the medium where the confidential information is stored (along with the owner's details), and follow the other steps required by the law (for example, define the procedure for dealings with the confidential information).

If one or more of these steps are ignored or omitted by the owner of the confidential information, the "trade secrets regime" will not be introduced and the information will not be protected as know-how. However, the "trade secrets regime" is not the only option for know-how subsistence and protection, as the owner of the confidential information may take certain other (reasonable) measures to preserve the secrecy of it.

Know-how is protected for as long as it is kept secret by its holder. If the confidentiality is lost, the exclusive right to know-how will lapse immediately.

### **Mask works**

Mask works represent integrated circuits' layouts. To be protected, a mask work must be creative/original and innovative.

Registration of a layout-design is not required, although optional registration with Rospatent can be carried out at any time during the term of protection.

The term of mask works protection is ten years from whichever is the earliest: the date of the first use of the layout-design (that is, the documented date of its introduction into commerce), or the date of registration of the layout-design with Rospatent.

### **Achievements of selection**

Achievements of selection represent plant varieties and animal breeds. To be protected, a plant variety or animal breed must be new, distinctive, uniform and stable.

Plant varieties and animal breeds must relate to botanical and zoological types of objects as defined by the Russian Ministry of Agriculture. The exclusive rights to achievements of selection are attested by the special patents issued by the Russian Ministry of Agriculture.

The general term of protection of achievements of selection is 30 years from the registration date. However, the term of protection for plant varieties such as grapes, decorative trees, fruit cultures and forest varieties are 35 years.

*For further information about the main IPRs, see [Patents, trade marks, copyright and designs in Russia](#).*

## **Maintaining IPRs**

### **Search and information facilities**

2. What facilities are available to conduct IP searches and obtain IP information on registered IP rights?

### **General**

The online databases of the Federal Service for Intellectual Property (Rospatent) are publicly available to conduct IP searches and to obtain any related information on registered IP rights and published applications. The online databases of the Eurasian Patent Organisation (EAPO) are also publically available to conduct patent searches and obtain relevant information on Eurasian patents and Eurasian published applications.

Information on Russian registered trade marks is available in the TMview online database system of the Office for Harmonization in the Internal Market (OHIM) ([www.tmdn.org/network/](http://www.tmdn.org/network/)), while information on Russian registered designs is available in the "DesignView" online database system of OHIM (<https://oami.europa.eu/eSearch>). Information on the international trade marks registered in Russia is also available in the ROMARIN online database of WIPO ([www.wipo.int/romarin](http://www.wipo.int/romarin)).

Different fee-based search tools are also available.

Possible IP infringements are usually monitored by the IP owners or their representatives, such as detective agents or law enforcement bodies (customs authorities). There is no centralised system or search engine that detects IP infringements on the market.

### **Patents**

See above, [General](#).

### **Trade marks**

See above, [General](#). Possible trade mark infringements are usually monitored by the trade mark owners or their representatives, such as detective agents or law enforcement bodies (customs authorities), provided that the registered trade mark is recorded in the special Customs IP Register of the Federal Customs Service (FCS) of Russia. There is no centralised system or search engine that detects trade mark infringements on the market.

### **Copyright**

There are no official registers for copyrights. Software and databases, if registered, can be searched for in Rospatent online databases. Possible copyright infringements are usually monitored by copyright owners or their representatives, such as detective agents or law enforcement bodies (customs authorities), provided that the copyrighted work is recorded in the special Customs IP Register of the FCS of Russia. There is no centralised system or search engine that detects copyright infringements on the market.

### **Design rights**

See above, [General](#).

### **Trade secrets and confidential information**

Trade secrets and confidential information are not subject to registration. Possible infringements of trade secrets and confidential information are usually monitored by the owners or their representatives, such as detective agents.

### **Mask works**

Mask works, if registered, can be searched for in Rospatent online databases. Possible infringements of mask works are usually monitored by the owners or their representatives, such as detective agents.

### **Achievements of selection**

Achievements of selection can be searched in the online databases of the State Commission of the Russian Federation on the Examination and Protection of Achievements of Selection. Possible infringements of achievements of selection are usually monitored by the owners or their representatives, such as detective agents.

### **Maintenance of main IPRs**

3. What steps must a business take to maintain the registration and legally protectable status of its main IPRs?

To maintain the registration and legally protectable status of its main IPRs a business must apply to the Federal Service for Intellectual Property (Rospatent) and pay maintenance fees (annuities) and/or renewal fees.

### **Patents**

The maintenance fees for invention patents accrue from the end of the second anniversary of the filing date and are payable upon grant. The application for extension of the patent term for pharmaceuticals, pesticides and agrochemicals must be filed not later than six months from the date of grant of the first authorisation or the date on which the patent was granted (whichever is later).

For utility model patents, maintenance fees (patent annuities) are payable from the first year. It is not possible to extend the protection for utility model patents.

If an owner fails to pay the maintenance fees, he will have six months to make the payment and will incur an additional charge.

### **Trade marks**

Trade marks can be renewed every ten years for an unlimited number of times. Renewal applications must be filed during the last year of each ten-year period of trade mark protection. However, for an additional charge they can be renewed within six months following the expiration of trade mark.

### **Copyright**

There is no need to maintain copyright protection as it is generally non-extendable.

### **Design rights**

The maintenance fees (patent annuities) for design rights accrue from the end of the second anniversary of the filing date and are payable on grant. Renewal applications must be filed during the last year of each five-year period of the term of design protection. If the owner fails to pay the maintenance fees, he has six months to make the payment under an additional charge.

### **Trade secrets and confidential information**

Trade secrets and confidential information are not subject to registration. Trade secrets are protected for as long as the confidential information is kept secret by its holder.

### **Mask works**

The term of protection of mask works is ten years and it cannot be extended.

### **Achievements of selection**

Patents for achievements of selection are valid for 30 years (35 years for certain achievements of selection). Maintenance fees (patent annuities) are payable from the first year after registration of a plant variety or animal breed.

## Monitoring infringement

4. What steps can a business take to avoid infringing another party's IPRs and to monitor whether another party is infringing its IPRs?

To avoid infringing another party's IPRs a business must consider taking the following steps:

- Conduct IP searches of the registries and the market (for example, freedom-to-operate).
- Register relevant IPRs or take other protection measures to ensure that a third party does not register the right first.
- Request freedom-to-operate and infringement legal opinions from experts (such as lawyers and patent, design or trade mark attorneys) to ensure that a particular action will not infringe the valid IPRs of others businesses.
- Approach the relevant IP owners and negotiate possible ways of avoiding IP infringement by taking certain commercial measures (such as assignment, licence and consent-to-use).
- Defend legitimate interests in court and with law enforcement bodies to challenge IP infringement.

To monitor whether another party is infringing their IPRs, the business must consider taking the following steps:

- Monitor the market through the agency of official representatives, detective agents and licensees, distributors or dealers.
- Request infringement legal opinions from experts (such as lawyers and patent, design or trade mark attorneys) to identify whether an infringement is occurring or has occurred.
- Approach the relevant infringer with cease and desist letters or take-down notices and negotiate possible ways of cessation of IP infringement on an extra-judicial basis.
- Issue a claim against the respective infringer in court and take other legal actions (such as administrative proceedings with law enforcement bodies) to stop IP infringement, seize and destruct counterfeits and claim damages or monetary compensation.

## Exploiting IPRs

5. What are the main steps in conducting an IP audit in your jurisdiction to determine the content of an IP portfolio?



## **IP audit**

The main steps in conducting an IP audit to determine the content and quality of an IP portfolio are:

- Obtaining IP-related information and documentation from the IP owner or target.
- Conducting IP searches and necessary investigations of the registers, public records, the market and the internet.
- Verifying the validity of the IP portfolio.
- Confirming the IP ownership.
- Reviewing IP agreements, employment contracts and encumbrances.
- Reviewing IP-related dispute resolution and litigation files as well as the status of existing dispute resolution claims.

## **Patents**

See above, [IP Audit](#). In addition, any disclosure statements and publications describing the invention or utility model must be requested and audited. Patent prosecution files must also be reviewed. Further, the compensation paid to employees for the inventions created and used in the course of employment relations must be audited.

## **Trade marks**

See above, [IP Audit](#). In addition, any actual and documentary confirmation of trade mark use in connection with all covered goods and services must be requested and audited. Trade mark prosecution files must also be requested and reviewed.

## **Copyright**

See above, [IP Audit](#). In addition, any copyright registrations, deposit certificates and copyright prosecution materials must be requested and audited. Further, the compensation paid to employees for the works created and used in the course of employment relations must be audited.

## **Design rights**

See above, [IP Audit](#). In addition, any design disclosure statements and publications related to designs must be requested and audited. Design prosecution files must also be reviewed. Further, the compensation paid to employees for the designs created and used in the course of employment relations must be audited.

## **Trade secrets and confidential information**

See above, [IP Audit](#). In addition, any documents relating to the implementation of the "trade secrets regime", or materials confirming the introduction of reasonable measures against confidentiality, must be requested and audited.

## **Mask works**

See above, [IP Audit](#). In addition, any mask works registration certificates and prosecution materials must be requested and audited. Further, the compensation paid to employees for layout-designs created and used in the course of employment relations must be audited. Documentary evidence of the date of first use of the mask work must be confirmed.

### **Achievements of selection**

See above, [IP Audit](#). In addition, any evidence describing the date of first sale or transfer of achievements of selection must be requested and audited. Relevant prosecution files must also be reviewed. Further, the compensation paid to employees for achievements of selection created and used in the course of employment relations must be audited. Evidence of market use allowance for achievements of selection and any relevant records must be confirmed.

## **Assignment**

### **Scope of assignment**

6. On what basis can the main IPRs be assigned?

Assignments of IPRs can be made in whole or in part (for trade marks and copyrights), with or without goodwill (for trade marks), and with jurisdictional restrictions (for international trade mark registrations and copyrights).

Under Russian Law, assignments of IPRs are deemed to be entire transfers or sales of the exclusive rights. Therefore, in general, IP assignment agreements do not contain any restrictions or limitations on the assignment of the contracted subject matters.

The assignment of future rights is not permitted, unless the assignment agreement represents a preliminary agreement that clearly sets out the:

- Subject matter and terms of the main assignment agreement.
- Period within which the main assignment agreement will be concluded by the parties.

An assignment in relation to trade marks may not be possible in the event that:

- The assignor wants to retain other confusingly similar trade mark registrations, designs and/or company names.
- The assignor wants to partially keep the trade mark registration in connection with certain other goods or services similar to the assigned ones.
- There are other grounds for misrepresentation or threats (risks) of confusion.

## Formalities for assignment

7. What formalities are required to assign each of the main IPRs?

An assignment must be made in writing and signed by both parties. The notarisation and legalisation of the deed of assignment is not required. However, it is mandatory to register the assignment of:

- Patents (including for inventions, utility models and designs).
- Trade marks and service marks (including under national and international registrations).
- Software and databases (if they are registered with the Federal Service for Intellectual Property (Rospatent)).
- Mask works (if they are registered with Rospatent).
- Achievements of selection (including for plant varieties and animal breeds).

### Patents

The registration of a patent assignment under a deed of assignment is required. The failure to register the patent assignment will result in the transfer of patent rights being invalid against third parties.

### Trade marks

The registration of a trade mark assignment under a deed of assignment is required. The failure to register the trade mark assignment will result in the transfer of trade mark rights being invalid against third parties.

### Copyright

The registration of a copyright assignment under a deed of assignment is not required. However, it must be made in writing.

The registration of a copyright assignment relating to software or database is only required if the contracted software or database is registered with Rospatent. The failure to register the copyright assignment of the registered software or database will result in the transfer being invalid against third parties.

### Design rights

The registration of a design assignment under a deed of assignment is required. The failure to register the design assignment will result in the transfer of design rights being invalid against third parties.

### Trade secrets and confidential information

The registration of an assignment of trade secrets and confidential information under the deed of assignment is not required. However, it must be made in writing.

### **Mask works**

The registration of an assignment of mask works under a deed of assignment is only required if the contracted mask work is registered with Rospatent. The failure to register the assignment of the registered mask work will result in the transfer of mask work rights being invalid against third parties.

### **Achievements of selection**

The registration of an assignment of an achievement of selection under a deed of assignment is required. The failure to register the assignment of the achievement of selection will result in the transfer of rights vested in the achievement of selection being invalid against third parties.

### **Main terms for assignments**

8. What main terms should be included in an assignment of IPRs?

The main terms that must be included in an assignment of IPRs are the:

- Details of the parties to the contract (that is, company names and addresses of the assignor and assignee as well as their authorised officers).
- Subject matter of the assignment agreement (that is, the IP registration numbers and a description of the IPRs – as applicable).
- Full scope of the assignment (that is, confirmation that the IPRs are being transferred in their entirety).
- Goods and services subject to the assignment (this is applicable to trade mark assignment only).
- Compensation clause (this is especially applicable to assignments between commercial organisations or companies).

## **Licensing**

### **Scope of licensing**

9. On what basis can the main IPRs be licensed?

### **Licensing**

IPRs can be licensed in whole or in part (under certain circumstances), with or without goodwill (in the case of trade marks), and with jurisdictional restrictions (the default territory is the whole of Russia).

IPR licences must also provide for the term (the default term is five years).

Licensing of IPRs can be done on a sole, exclusive or non-exclusive basis.

Other limitations and provisions can be provided for in the licence agreement.

### **Patents**

See above, [Licensing](#).

### **Trade marks**

See above, [Licensing](#). Trade marks can be licensed either in connection with all goods or services covered by trade mark registrations, or in connection with specific ones covered by trade mark registrations. Goods and services that are not indicated in trade mark registrations may not be licensed.

### **Copyright**

See above, [Licensing](#).

### **Design rights**

See above, [Licensing](#).

### **Trade secrets and confidential information**

See above, [Licensing](#).

### **Mask works**

See above, [Licensing](#).

### **Achievements of selection**

See above, [Licensing](#).

### **Formalities for licensing**

10. What are the formalities to license each of the main IPRs?

### **Licence agreement**

A licence agreement must be made in writing and signed by both parties. The notarisation and legalisation of the licence agreement is not required. However, it is mandatory to register the licences of:

- Patents (including for inventions, utility models and designs).
- Trade marks and service marks (including under national and international registrations).
- Mask works (if they are registered with the Federal Service for Intellectual Property (Rospatent)).
- Achievements of selection (including for plant varieties and animal breeds).

### **Patents**

See above, [Licence agreement](#). The registration of a patent licence under a licence agreement is required. The failure to register the patent licence will result in it being invalid against third parties.

### **Trade marks**

The registration of a trade mark license under a licence agreement is required. Failure to register the trade mark licence will result in it being invalid against third parties.

### **Copyright**

The registration of a copyright licence, including over a registered software or database, is not required. However, the copyright licence must be made in writing.

### **Design rights**

See above, [Patents](#).

### **Trade secrets and confidential information**

The registration of licences of trade secrets and confidential information under licence agreements is not required. However, they must be made in writing.

### **Mask works**

The registration of a licence of a mask work under a licence agreement is only required if the mask work has been registered with Rospatent. The failure to register the licence of the registered mask work will result in it being invalid against third parties.

### **Achievements of selection**

See above, [Patents](#).

## Main terms for licences

11. What main terms should be included in an IP licence?

The main terms that must be included in an IP licence are the:

- Details of the parties to a contract (that is, company names and addresses of licensor and licensee as well as their authorised officers).
- Subject matter of the licence (that is, the IP registration numbers and a description of the IPRs – as applicable).
- Details of the licensed goods or services subject to the trade mark registrations (applicable only to a trade mark licence).
- Type of licence (that is, whether it is sole, exclusive or non-exclusive).
- Licensable rights (that is, the specifically permitted use of the IPR).
- Compensation clause, (this is especially applicable to the licence arrangement between commercial organisations or companies).
- Licensed territory (the default territory is the whole of Russia).
- Licensed term (the default term is five years).
- Sublicence clause (that is, whether sublicensing is permitted automatically or whether it is subject to the consent of the licensor).
- Termination for convenience clause (that is, whether the licensor and licensee has the right to unilaterally terminate the licence).

## Taking security

12. What are the key issues in taking security over the main IPRs?

Security interests over IPRs are usually taken in the form of a pledge or a fixed charge. Trade mark, design, copyright and software security interests are currently the most common pledges or charges in Russia.

However, certain IPRs cannot be secured under the law, or can only be pledged or charged under certain limitations or restrictions. As a result, they may not be enforceable. For instance, it is not possible to pledge company names and trade names as separate IP subject matters. Furthermore, a charge over exclusive rights to a copyrighted work (owned by the author of the work) will only be valid if the author is a party to the security agreement and such an agreement clearly defines the copyrighted work subject to the collateral.

The valuation of security over IPRs and the enforcement of security interests may be problematic for the following reasons:

- In most cases it is difficult for parties to properly evaluate secured IPR assets at the start of their business transactions.
- The enforcement of IPR security interests can be very difficult, if not impossible, to the extent that some IPR collateral (such as, patents for inventions or utility models) will eventually lose their real value.
- The pool of potential buyers of secured IPR assets (in the course of foreclosure proceedings) is usually narrower in comparison to the other secured assets (such as, real property, which are much easier to trade with).
- Third party creditors are not interested in acquiring secured IPR assets in situations where these assets are close to expiration.

Therefore, pledges over IPRs are usually taken in addition to further security interests, such as mortgages, pledges of company shares or equipment liens.

In practice, judicial and non-judicial foreclosures are used to enforce IPR security interests. Non-judicial foreclosures may be faster up to a certain extent.

### 13. What are the main security interests taken over IPRs?

#### **Security interests**

A security agreement must be in writing and signed by both parties. The notarisation and legalisation of the security agreement is not required. To be able to enforce the contacted security interests, the security agreements of the following IPRs must be registered:

- Patents (including for inventions, utility models and designs).
- Trade marks and service marks (including under national and international registrations).
- Mask works (if they are registered with the Federal Service for Intellectual Property (Rospatent)).
- Achievements of selection (including for plant varieties and animal breeds).

#### **Patents**



See above, [Security interests](#). The registration of a patent security interest under a security agreement is required. The failure to register the patent security interest will result in the security interest being invalid against third parties.

### **Trade marks**

The registration of a trade mark security interest under a security agreement is required. The failure to register the trade mark security interest will result in the security interest being invalid against third parties.

### **Copyright**

The registration of a copyright security interest, including over a registered software or database, is not required. However, it must be made in writing.

### **Design rights**

See above, [Patents](#).

### **Trade secrets and confidential information**

The registration of security interests of trade secrets and confidential information under security agreements is not required. However, security interests over trade secrets and confidential information must be made in writing.

### **Mask works**

The registration of a security interest of a mask work under a security agreement is only required if the mask work has been registered with Rospatent. Failure to register the security interest over the registered mask work will result in it being invalid against third parties.

### **Achievements of selection**

See above, [Patents](#).

## **M&A**

### **Due diligence**

14. What IPR-related due diligence is commonly carried out in both a share sale or merger and an asset sale?

In a share sale or merger and an asset sale transaction, the target usually provides the following information and documents to the other side, for the purposes of due diligence:

- Corporate and IP structures (that is, a description of the business and a list of the IP holding companies).

- IP portfolios (including all pending applications, relevant prosecution materials and valid IP registrations).
- Related portfolios (including portfolios on the IT systems, domain names and media).
- Documents confirming IP maintenance and payment of maintenance fees (including patent annuities and renewal fees).
- Deeds of assignment and transfer agreements.
- Licence and sub-licence agreements.
- Franchise and sub-franchise agreements.
- Distribution and supply agreements.
- Employment and labour agreements (governing creation and transfer of IPRs).
- Service and development agreements (governing the creation and transfer of IPRs).
- Internal regulations on protection of trade secrets and confidential information.
- Non-disclosure and confidentiality agreements.
- Dispute resolution and litigation files (describing all relevant offensive and defensive IPR infringements, whether occurred, current/pending or threatened. This also includes the status of judgments that are being enforced and any consequences or risks relating to IPR infringements (including payment of damages or monetary compensation).

Depending on the nature of the transaction, the nature of the IPRs subject to due diligence and the target's business, the other side may also request the other specific information and documentation from the seller.

### **Warranties/indemnities**

15. What IPR-related warranties and/or indemnities are commonly given by the seller to the buyer in both a share sale or merger and an asset sale?

In a share sale or merger and an asset sale transaction, the seller will usually represent and warrant to the buyer that:

- The seller has disclosed all the information and documentation related to its IPRs.
- The seller has all legal titles to its IPRs and all the IPRs are valid.
- The IPRs are properly created, protected, registered, maintained and renewed (as applicable).
- The IPRs are not pledged, assigned, conveyed, seized or arrested.
- There is no infringement of third-party IPRs.
- The seller has no action or claim enforcing its IPRs against third parties.

- The seller will indemnify, defend, and leave the buyer harmless from and against any liability, financial loss, damage or expense arising from any breach of the above representations and warranties.

Depending on the nature of the transaction, the nature of the IPRs subject to due diligence and the target's business, the seller may be required to provide the other specific representations and warranties to the buyer.

## Transfer of IPRs

16. How are the main IPRs transferred in both a share sale or merger and an asset sale?

### Share sale or merger

In a share sale or merger transaction, there is no physical or technical transfer of IPRs, as they remain legally vested with the target. In other words, the target continues to hold the exclusive rights to the IPRs, while the buyer takes "corporate" possession of the target. However, the parties to a share sale or merger deal must check and ensure that they comply with any change of control and share or merger non-assignment restrictions prior to the transaction.

### Asset sale

In an asset sale transaction, every IPR must be physically or legally assigned to the buyer. Therefore, the asset purchase contract and the underlying assignment agreement must specify every IPR (including the relevant IPR registration numbers). In many cases, each IPR will have a separate underlying assignment agreement (for example, patent assignment agreement, trademark assignment agreement).

The parties must also ensure that the formalities for a valid IP assignment are duly complied with (*see Question 7*). Further, the parties to an asset sale transaction must check and ensure that they comply with any change of control and asset non-assignment restrictions prior to the transaction.

## Joint ventures

17. Is it common for companies to set up joint ventures in your jurisdiction to develop projects that heavily involve IPRs?

It is common for two or more companies (in particular companies involved in various areas of technology) to set up joint ventures to develop IPR-related projects in Russia.

The law does not provide any specific requirements as to what IP-related provisions must be included in the joint venture agreements. However, because such transactions are primarily based on licensing, sub-licensing, or even cross-licensing arrangements of the parties, the parties must observe Russian IP licensing and registration regulations, even if such transactions are governed by the foreign law.

In addition, the parties can also provide the following provisions in the joint venture agreements:

- A definition of the scope of the licensing subject matters and licensable rights.
- The value of the licensed IPR and an allocation of profits.
- Termination and exit provisions.
- Post-termination rights and obligations.

Other IP-related and licensing provisions can be also included in the joint venture agreements, depending on the nature of transactions, the nature of the IPRs and the relevant business project.

## Competition law

### Main provisions and common issues

18. What are the main provisions of your national competition law that can affect the exploitation of the main IPRs?

### Anti-competitive practices

Anti-competitive practices that restrict trade on the market, including "cartels" (that is, agreements between competitors trading on the same product market), are prohibited, if they involve:

- Fixing or supporting prices, discounts, mark-ups (additional payments) and extra charges.
- An increase, decrease or support of prices at tenders.
- A division of the product market by territory, volume of sales, purchase of products, assortment of the products sold or composition of sellers or purchasers (customers).
- Limitation or termination of the product manufacture (production).
- Refusal to enter into agreements with certain types of sellers or purchasers (customers).

Other prohibited agreements that lead or can lead to restraint of competition are:

- Tying a counterparty to enter into an agreement containing certain provisions that are disadvantageous or unrelated to the subject matter of the agreement. This can include unreasonable requirements to transfer

monetary funds or other property (including proprietary rights) and the consent to enter into an agreement only on the condition that it includes provisions related to products in which the counterparty is not interested.

- Economically, technologically or otherwise setting different prices for the same products.
- Creating barriers to other business entities for product market entries or exits.
- Setting conditions to participate in professional and other associations.

In addition, the above activities will be banned, if they are regarded as concerted actions of business entities that limit competition on the market.

### **Abuse of dominance and unfair competition**

Abuse of dominance and unfair competition are not allowed. In practice, the following acts are regarded as unfair competition and are therefore prohibited by the law:

- Dissemination of false, inaccurate or distorted information that can inflict damages to a legal entity or impair the legal entity's business reputation.
- Misleading acts concerning the:
  - nature, method and place of production of the products;
  - products' characteristics, quality and quantity;
  - products' manufacturers; or
  - terms of sale, including with regard to the price of products.
- Incorrect comparison of the legal entity's products with the products manufactured or sold by other legal entities.
- The sale, exchange or other marketing of products bearing the illegally used patents, copyrights and other IPRs, except for means of identification (such as trademarks).
- Illegal use of trademarks, trade names and other means of identification (such as company names) in commerce or on the Internet, including in the domain name and other types of addressing.
- Copying or imitation of the appearance of the product, its packaging, trade dress or other elements individualising the company or its product.
- Illegal acquisition, use or disclosure of information containing commercial, employee or other proprietary information (trade secrets).
- The unauthorised acquisition and use of another legal entity's trademarks, trade names and other means of identification (such as company names).

Further, the acquisition and use of another legal entity's exclusive right to IP is not permitted as it will be regarded as unfair competition.



19. What are the most common national competition law issues that arise in the exploitation of the main IPRs?

In Russia, the exploitation of IPRs, including in the format of licensing, are exempt from the national competition law issues contained in [Question 18](#).

Therefore, there will be no competition law issues in respect of the following provisions set out in IP licence agreements:

- Term of IPR licences.
- Territory of IPR licences.
- Exclusivity and permitted use of IPRs.
- Fixation of a licensee's reselling prices and tie-in clauses.

### Exclusions/exemptions

20. What exclusions or exemptions are available for national competition law issues involving the exploitation of the main IPRs?

In Russia, the exploitation of IPRs, including under IP licence agreements, is exempted from the antimonopoly regulation (see [Question 19](#)).

## Advertising

21. To what extent do advertising laws impact on the use of third party trade marks?

Under the common rule of law, third party trade mark advertisements are only permitted with the trade mark owner's consent. Unauthorised third party trade mark advertising is prohibited and may be prosecuted. In general, advertising must be fair and authentic.

The law prohibits unfair advertising that contains or represents:

- An act of comparative advertising, which:
  - involves incorrect comparisons of the advertised products with products in circulation, that are manufactured by other manufacturers or sold by other sellers;
  - impairs the business reputation of the person (competitor); or
  - is passing off the image of another product, on which there is a trade mark that is identical or confusingly similar to the trade mark placed on the product that is subject to certain advertising requirements and restrictions, or passing off the real manufacturer or seller of such product.
- An act of unfair competition, which is prohibited under the anti-monopoly legislation.

The law also prohibits false advertising that contains or represents incorrect information on:

- Advantages or benefits of the advertised products.
- Any product characteristics.
- Costs or prices of the products.
- Product delivery and maintenance terms.
- Warranty conditions.
- Exclusive rights to IP objects.
- Volume of manufacture or sale of the advertised products.
- Rules and terms of contests, games or other similar entertainment events.
- Rules and terms of sweepstakes and games-on-bets.
- Manufacturers or sellers of the advertised products.

Breaches of the relevant provisions of the advertising legislation can lead to different types of liability (for example, administrative fines).

## Employees and consultants

22. Who owns each of the main IPRs created by an employee in the course of his employment? Must compensation be paid to the employee? What main steps can an employer take to ensure it owns each of the main IPRs?

### Ownership

An employer is the valid owner of the main IPRs created by its employees in the course of their employment, unless the employment or civil-law agreement provides otherwise. However, the IPRs will be transferred back to

the employees if the employer, within four months (in case of patents) or within three years (in case of copyrights), does not:

- File an application for registration (or for copyrights, start using the work).
- Assign the IPR (that is, patent or copyright) to a third party.
- Keep the information relevant to the IPR secret.

Moral rights, including the right of attribution and integrity, always remain with the employee.

### **Compensation**

The employee will enjoy the right of compensation if the employer does any of the following acts:

- Obtains a patent.
- Fails to obtain a patent (under the reasons depending on him).
- Starts using the copyrighted work.
- Assigns the IPR (that is, patent or copyright) to a third party.
- Decides to keep the information relevant to an IPR in secrecy.

The amount of such compensation and the terms of payment of the same must be determined by an agreement between the parties and in the event of a dispute, by the court.

### **Main steps**

To ensure ownership over IPRs created by an employee in the course of employment relations, the employer must:

- Provide in the employment agreement that the employer will own the legal title of and exclusive rights to any IPRs created by the employee during the course of his employment.
- Document the employee's duties and specific instructions of the employer, especially with regard to relevant IPRs created by the employee.
- Document the process of notification of creation of relevant IPRs created by the employee.
- Sign a civil-law contract with the employee governing the amount and terms of payment of compensation for the relevant IPRs created by the employee.
- Perform (timely and accurately) the necessary actions, as required by the law to secure the valid legal title over and exclusive rights to the IPRs created by the employee (for example, file a patent application or start using the copyrighted work).

23. Who owns each of the main IPRs created by an external consultant? What main steps can a business take to ensure it owns each of the main IPRs?



## Ownership

Under the common rule of law and court practice, the contract must define the ownership of the main IPRs created by an external consultant.

The law distinguishes between a specifically contracted IPR (that is, IP on order) and a non-contracted IPR (that is, IPR during works or research and development (R&D)), when the external consultant is engaged by the business:

- In the first scenario, unless otherwise agreed, the main IPRs are owned by the business under a contract of commission, whereby the creation of a specific IPR is properly defined and requested from the external consultant. In this case, the external consultant has the right to use the created IPR, within the relevant term of IPR protection, on a non-exclusive and free-of-charge basis for his own purposes, unless the agreement provides otherwise.
- In the second scenario, unless otherwise agreed, the main IPRs are owned by the external consultant under the R&D or another development agreement, whereby the creation of a specific IPR is not defined or requested, but certain IPR is developed in the course of scientific or technological works made by the external consultant. In this case, the business has the right to use the created IPR, within the relevant term of IPR protection and on the non-exclusive and free-of-charge basis for the purposes of the contract, unless the agreement provides otherwise.

In the copyright industry, the external consultant being a physical person will enter into a work-made-for-hire contract with the business, which will usually set out the:

- Nature of the copyrighted work requested by the customer.
- The assignment or licence in relation to copyrighted work.
- The terms of transfer of property rights over the media in which the copyrighted work is embodied.

## Main steps

To ensure ownership over the IPRs created by the external consultant, the business must:

- Sign the contract of commission or development contract (as applicable) by specifying the customer's legal title and exclusive rights to IPRs.
- Include specific provisions on transfer of IPR ownership in case the external consultant engages third parties.
- Negotiate an assignment of IPRs in case the same are vested with the external consultant under the valid provisions of the contract of commission or development contract or the law (as applicable) and secure registration of the assignment of the registered IPRs (as applicable).
- Provide a copyright assignment clause in the work-made-for-hire contract with the external consultant (physical person) describing the exact terms of the assignment (in addition to the transfer of property rights over media).

## Tax

24. What are the main taxes payable by a licensor on the licensing of the main IPRs?

There is no specific IPR licensing tax in Russia. A licensor must pay corporate income tax (CIT) and value added tax (VAT) on the licensing of its IPRs. In addition, the licensor must observe certain local transfer pricing rules.

### **CIT/withholding Tax**

The Russian licensor must pay 20% CIT on royalties received from the Russian licensee.

Royalties payable to a foreign licensor by a Russian licensee are subject to a 20% withholding tax. The Russian licensee must act as a tax agent for the foreign licensor and must remit the withholding tax amount to the state budget on the licensor's behalf. If the foreign licensor is established in and operates under the laws of a foreign state that has a special tax treaty with Russia, a zero or reduced tax rate is applied. To enjoy such a tax relief, the foreign licensor must provide the Russian licensee with valid documentary proof of its tax residency in the relevant foreign state. This must be certified by the competent government authority.

### **VAT/withholding tax**

The Russian licensor charges 18% VAT on royalties payable by the Russian licensee and must remit the tax to the state budget.

The foreign licensor must charge 18% VAT on royalties payable by the Russian licensee. If the foreign licensor does not have a permanent establishment or a representative office in Russia, the Russian licensee must act as a tax agent for the foreign licensor. He must withhold the VAT amount from royalties and remit it to the state budget. Licence agreements usually contain "gross-up" provisions, under which the amount of royalties paid to the foreign licensor is grossed up by 18%.

The licensing of patents, know-how, software, databases and mask works is exempt from VAT.

### **Transfer pricing**

According to the local transfer pricing rules, the price of products and services specified in a contract between affiliated persons must comply with the market price of those products and services. Therefore, if the licensor and the licensee are affiliated persons, and the contract price indicated in the underlying licence agreement is not consistent with the market price, additional taxes and penalties will be charged.

The transfer pricing rules may also be applicable to a licence agreement concluded between non-affiliated parties, if one of the following applies:

- The licence agreement are made through the participation of the so-called "intermediaries" (non-affiliated) and directed at the resale of the products or services, provided that such "intermediaries":
  - do not perform any other functions;
  - do not accept any risks; and
  - do not use any assets for the purposes of organisation of the resale of the products or services.
- One of the parties to the agreement is a resident of an offshore jurisdiction as set out in the official List of Ministry of Finance (2007). This includes Anguilla, Andorra, Bahrain, Belize, the British Virgin Islands, China (Hong Kong and Macao), Gibraltar, Grenada, the Isle of Man, Liberia, Liechtenstein, the Maldives, the Marshall Islands, Monaco, Panama, San Marino, the Seychelles, the United Arab Emirates and other offshore jurisdictions.

25. What are the main taxes payable by a seller on the sale of the main IPRs?

There is no specific IPR assignment tax in Russia. An assignor must pay corporate income tax (CIT) and value added tax (VAT) on the assignment of its IPRs.

The taxes payable under IPR assignments are similar to taxes payable on the licensing of IPRs (see [Question 24](#)).

## Cross-border issues

26. What international IP treaties is your jurisdiction party to?

Russia is party to the following major international IP treaties:

- WIPO Paris Convention for the Protection of Industrial Property 1883.
- Singapore Treaty on the Law of Trademarks of 18 December 2009.
- WIPO Patent Law Treaty 2000.
- WIPO Copyright Treaty 1996.
- WIPO Performances and Phonograms Treaty 1996.

- WIPO Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations 1961.
- WIPO Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks 1989.
- WIPO Berne Convention for the Protection of Literary and Artistic Works 1971.
- Convention for the Protection of Producers of Phonograms Against Unauthorised Duplication of Their Phonograms 1971.
- WIPO Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite 1974.
- Nairobi Treaty on the Protection of the Olympic Symbol of 17 April 1986.
- Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure 1977.
- Patent Cooperation Treaty 1970.
- WIPO Strasbourg Agreement Concerning the International Patent Classification 1971.
- WIPO Madrid Agreement Concerning the International Registration of Marks 1891.
- Locarno Agreement Establishing an International Classification for Industrial Designs 1968.
- WIPO Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks 1957.
- Convention Establishing the World Intellectual Property Organisation 1967.
- WTO Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.
- International Convention for the Protection of New Varieties of Plants 1961.
- UN Universal Copyright Convention 1952.
- Agreement on Unified Principles of Regulation in the Spheres of Intellectual Property Rights Protection of 1 January 2012.
- EAPO Eurasian Patent Convention 1994.
- Agreement on Cooperation in the Field of the Protection of Copyright and Neighboring Rights of 6 May 1995.
- Agreement on the Creation of Common Customs Territory and Establishing of Customs Union of 10 October 2008.
- Agreement on the Establishment of the Common Economic Zone of 20 May 2004.
- Treaty on the establishment of the Eurasian Economic Community of 5 June 2002.
- Agreement on Customs Union and Common Economic Zone of 2 July 2001.

A detailed list of treaties can be found at: [www.wipo.int/wipolex/en/profile.jsp?code=RU](http://www.wipo.int/wipolex/en/profile.jsp?code=RU)

27. Are foreign IPRs recognised in your jurisdiction?

Foreign IPRs are not automatically recognised in Russia except in relation to:

- Eurasian patents obtained under the valid provisions of the EAPO Eurasian Patent Convention 1994 (Eurasian Patent Convention).
- Trade marks filed under the WIPO Madrid Agreement Concerning the International Registration of Marks 1891 (Madrid Agreement) and the Madrid Agreement concerning the International Registration of Marks and the Protocol Relating to that Agreement 2004 (Madrid Protocol).
- Copyrights protected under the WIPO Berne Convention for the Protection of Literary and Artistic Works 1971 (Berne Convention).

Many treaties allow late filing of applications in Russia if the application has already been filed elsewhere (for example, under the WIPO Paris Convention for the Protection of Industrial Property 1883 (Paris Convention) or the Patent Cooperation Treaty (PCT)).

### **Patents**

Russia is a member of the Paris Convention, PCT and the Eurasian Patent Convention.

Under the Paris Convention, a patent application that is first filed with another party to the convention will be given a foreign filing priority date. This means that a patent application that is first filed with another party to the convention can be filed in Russia within 12 months.

The PCT provides for a unified procedure for filing patent applications in several countries. The applicant must file a single application at a designated PCT receiving office. If the applicant then wants to proceed to the grant and registration of the patent, the Federal Service for Intellectual Property (Rospatent) will process a national phase entry of application.

The Eurasian Patent Convention provides for a grant of the unitary patent that is to be registered and granted in Russia and all other valid jurisdictions that are member states to the EAPO regime. In other words, it is a single regional patent that will be effective (upon its grant) in eight jurisdictions at once, including Russia, Belarus, Kazakhstan, Kyrgyzstan, Armenia, Azerbaijan, Tajikistan and Turkmenistan.

### **Trade marks**

Russia is a member of the Paris Convention, Madrid Agreement and the Madrid Protocol.

Under the Paris Convention, trade mark applications that are first filed with another party to the convention are given a foreign filing priority date. This means that a trade mark application that is first filed with another party to the convention can be filed in Russia within six months.

Trade mark applications filed under the Madrid Agreement and the Madrid Protocol can also receive protection in Russia under an international registration. Classes of goods and services can be selected and protected under the WIPO Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks 1957 (Nice Agreement).

## Copyright

Russia is a member of the Berne Convention. Under the Berne Convention copyright that subsists under the law of a member state is given the same protection in Russia.

Registration is not required as a condition precedent for copyright protection. However, it is possible to register software and databases – on an optional basis – with Rospatent.

## Design rights

Russia is a member of the Paris Convention. Under the Paris Convention, design right applications that are first filed with another party to the convention are given a foreign filing priority date. This means that a design application that is first filed with another party to the convention can be filed in Russia within six months.

Classes of industrial designs can be selected and protected under the Locarno Agreement Establishing an International Classification for Industrial Designs 1968.

## Trade secrets and confidential information

Trade secrets and confidential information must not be registered. However, the owner must undertake certain reasonable measures to protect the confidentiality of its information (know-how) (see [Question 1, Trade secrets and confidential information](#)).

## Mask works

Registration is not required to protect mask works. However, it is possible to register them – on an optional basis – with Rospatent (see [Question 1, Mask works](#)).

## Achievements of selection

Russia is member of the International Convention for the Protection of New Varieties of Plants 1961 (UPOV Convention). Under the UPOV Convention, patent applications for achievements of selection that are first filed with another party to the convention are given a foreign filing priority date. This means that patent applications for achievements of selection that are first filed with another party to the convention can be filed in Russia within 12 months.

## Reform

28. Are there any proposals for reform?

Russian laws are currently evolving and undergoing a fundamental civil-law reform.

In 2013, a specialised IP court started operating in Russia. This court has already had many positive results for IPR enforcement and litigation.

Between 2014 and 2015, there were several amendments to the Russian Civil Code regarding the:

- Registration and protection of IPRs.
- Use and exploitation of IPRs.
- Disposal of the IPRs and transactions.
- Enforcement and dispute resolution aspects of IPRs.

One of the major changes to the law is the simplification of the registration procedure for all the transactions and agreements involving registered IPRs. The new procedure no longer requires the contracting parties to disclose the signed agreements, financial information or other sensitive information to the authorities, as part of the application for registration. Instead, the parties can submit the so-called "statements of IP disposal" (notification) by describing all the essential elements and material terms of their agreements, except for the financials and other irrelevant data.

This new registration process has already improved the position of national and international companies, which can now carry out business related to their IPRs on a more confidential basis in Russia.

Further modification of Russian law, including from the IP perspective, is continually being discussed and there are likely to be further amendments in the near future.

## Online resources

### **Federal Service for Intellectual Property (Rospatent)**

**W** [www.rupto.ru/rupto/portal/start?lang=en](http://www.rupto.ru/rupto/portal/start?lang=en)

**Description.** The official website of Rospatent in English. It provides information on Rospatent's structure, functions, activities and international co-operation. It also provides Rospatent's annual reports and statistics, as well as related official news and laws on the protection of Russian IPRs.

### **Federal Institute of Industrial Property (FIIP)**

**W** [www1.fips.ru](http://www1.fips.ru)

**Description.** The official website of FIIP in Russian. It provides information on FIIP's services and fees, R&D, presentations of FIIP, access to patent-related documentation and information. It also provides official publications, online search databases and some related news and regulations related to the registration of IPRs and IP agreements in Russia.

### **Eurasian Patent Organization (EAPO)**

**W** [www.eapo.org/en](http://www.eapo.org/en)

**Description.** The official website of EAPO in English. It provides information on the Eurasian patent system and international co-operation, general information on Eurasian patent prosecution, official publications, online search databases and some related news and legislative acts related to EAPO regime.

## Contributor profiles

**Sergey Medvedev, PhD, LLM, Senior Lawyer, Registered Trademark and Design Attorney, Registered Software and Database Attorney**

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**Professional qualifications.** Russia, Lawyer, 2005; Software and Database Attorney, 2013; Trade mark Attorney, 2014; Design Attorney, 2015

**Areas of practice.** IP and IT; IP/IT agreements; transactions and restructurings; IP/IT due diligence and audits; IP/IT in corporate and commercial transactions; data protection and privacy; internet and e-commerce; media and entertainment; unfair competition and false advertising; dispute resolution and litigation; anti-counterfeiting and anti-piracy.

**Non-professional qualifications.** LLB in International (Private) Law, Moscow State University of International Relations, 2005; LLM in IP Law, The John Marshall Law School (Chicago, USA), 2007; PhD in Civil, Business and International Law, Russian Academy of Intellectual Property (Moscow, Russia), 2012

### Recent transactions



- Advising the leading Russian state corporation operating in the nuclear industry on IP/IT restructurings and IP/IT corporate concentration as part of its joint venture transaction with the largest German multinational engineering conglomerate; counselling the company on various patent, know-how, software, licensing/sublicensing, accounting, taxation and commercial issues; conducting IP/IT due diligence comprising the legal review of more than 600 subject matters; advising the company on the most significant risks in connection with the transaction.
- Advising the biggest Russian oil company on IP restructuring and reorganization in connection with its acquisition of another largest oil producer; counselling the company on various trademark, patent, design, licensing/sublicensing, corporate and commercial issues; conducting IP due diligence; advising the company on the most significant risks in connection with the transaction.
- Advising the worldwide US-based leader in NC advanced post-processing solutions on its asset sale/purchase transaction with the famous Russian IT holding company; counselling the company on various trademark, domain name, software, database, licensing, employment, corporate and commercial issues; conducting IP/IT due diligence; advising the company on the most significant risks in connection with the transaction; performing post-transaction work and assignment registrations in Russia and other jurisdictions.
- Advising the reputable US biopharmaceutical company on its multi-million joint venture and exclusive technology transfer project directed at the Russian and neighbouring markets; counselling the company on various patent, corporate, commercial and licensing/sublicensing issues; conducting patent due diligence; reviewing corporate and commercial agreements; reviewing and preparing patent license and sublicense agreements; registering patent licences and sublicences in Rospatent and other IP Offices.
- Advising a reputable Russian bank on various software issues under the licensing transaction with another reputable Russian bank.
- Advising the leading Russian insurance alliance on various database and IT issues; securing database registrations; preparing database licence agreement and mobile app user agreement.
- Advising a famous American bar/restaurant brand on its development on the Russian market; conducting trade mark due diligence; preparing and reviewing trade mark licence agreements; registering trade mark licences in Rospatent.
- Advising the reputable Japanese beer producer on various trademark, commercial, advertising and licensing issues; conducting trademark and advertisement due diligence; reviewing and preparing license and sublicense agreements; registering licences and sublicences in Rospatent.
- Advising a famous Russian bank on taking security over various IP assets of a leading Russian vodka company under a credit/facility transaction; reviewing and preparing security documents and registering the patent, design and trademark security interests in Rospatent.
- Advising a privately owned American pharmaceutical company specializing in the development and marketing of qualitative over-the-counter (OTC) drugs and nutritional products on the grant of security interest over its 100 brands in favor of the leading Swiss bank under the credit/facility transaction; counselling the company on various trademark, commercial and security issues; conducting trademark due diligence; reviewing and preparing the trademark security agreement; registering the trademark security interest in Rospatent.
- Advising the leading American sports nutrition and dietary supplements brand on its development on the Russian market; counselling the company on various trade mark, corporate and commercial

issues; reviewing and preparing the master development and franchise agreement; registering the franchise in Rospatent.

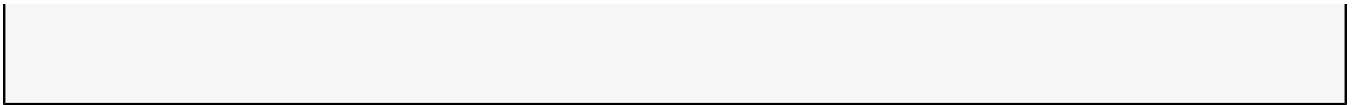
- Advising the global leading US-based hospitality brand on its expansion in four major cities of Russia; counselling the company on various trade mark, commercial and franchising issues; reviewing the international franchise agreements; registering the franchises with Rospatent.
- Advising the prominent UK-based company on various IP issues in connection with its water supplies into Russia; counselling the company on the supply and distribution agreement; conducting trademark and product due diligence; reviewing and preparing the supply and distribution agreement.

**Languages.** Russian, English, French

**Professional associations/memberships.** Licensing Executive Society (LES); International Franchising Association (IFA); International Trademark Association (INTA); European Franchise Lawyers (EFL).

### **Publications**

- *Security Interests in Intellectual Assets. The New Era (in Russian), Patents & licences, No. 9, 2010.*
- *Unique Types of Security Interests in Intellectual Property (in Russian), Law and Politics, No.6, 2012.*
- *Licensing, Chapter on Russia, Getting The Deal Through (GTDT) by Law Business Research (LBR), 2014.*
- *Customs Value, Licensing and Royalties – The Russian Perspective, Les Nouvelles, 2014.*
- *Licensing, Chapter on Russia, Getting The Deal Through (GTDT) by Law Business Research (LBR), 2015.*
- *Co-authorship with Vladimir Biriulin, Partner at Gorodissky & Partners Franchise, Chapter on Russia, Getting The Deal Through (GTDT) by Law Business Research (LBR), 2015.*
- *Franchise, Chapter on Russia, International Comparative Legal Guide (ICLG) by Global Legal Group (GLG), 2015.*
- *Intellectual Property Rights: Legislation, Regulations, Directives and Policies – Overview of and Licensing the Main IP Rights in Russia, Chapter 2 on Russia, International Licensing and Technology Transfer: Practice and the Law by Wolters Kluwer.*
- *Tax Considerations in Structuring International Licensing and Technology Transfer Arrangements, Chapter 5 on Russia, International Licensing and Technology Transfer: Practice and the Law by Wolters Kluwer.*
- *Co-authorship with Vladimir Biriulin, Partner at Gorodissky & Partners and Ilya Goryachev, Lawyer at Gorodissky & Partners Competition Law – International Licensing, Chapter 6 on Russia, International Licensing and Technology Transfer: Practice and the Law by Wolters Kluwer.*
- *Drafting Patent licences: Commentary and Sample Clauses, Chapter 7.1 on Russia, International Licensing and Technology Transfer: Practice and the Law by Wolters Kluwer.*



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